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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,919	07/10/2000	Emil Breeding	PM 271581	9519

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EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,919

Applicant(s)

BREIDING ET AL.

Examiner

CHAN S PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 7 is objected to because of the following informalities: a method is claimed instead of a system. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6 provide for the use of a method, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. Claims are indefinite where they merely recite a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

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definition of a process, i.e., results in claims which are not proper process claims under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen U.S. Patent No. 6,509,974 in view of Bowman-Amuah U.S. Patent No. 6,636,242.

1. With respect to claim 1, the Hansen reference teaches a method of allowing a customer (col. 3, lines 59-62) to a printing service provider (store front 114 in conjunction with print server 120) to create a PDF document (col. 4, lines 26-37) at the site of the customer through a computerized interface and sending the PDF document to the service provider through a network for data communication (col. 3, lines 26-33), whereby the service provider directs the PDF document to the suitable printing office through a network for data-communication (col. 7, lines 1-10), comprising that a PDF engine creating documents uses XML files to create a customer PDF document for printing on demand (col. 17, lines 13-31). It further discloses said PDF engine generating said document through providing a new structure by analyzing the XML file,

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while analyzing merging data and formatting information and thus making it possible to create a PDF document with a distinct difference between data to be printed and the design of the PDF document (col. 17, lines 22-30).

The reference teaches that the service provider is capable of interpreting PDF data received by the customer. Therefore, it can be concluded that a user can generate a PDF data.

The Office interpreted "embedding them (XML) within an unused portion of the ready for printer format code" as "embedding XML within PDF file" (col. 17, lines 17-19).

The Hansen reference does not disclose expressly that a PDF engine creating documents uses first and second XML files to create a customer PDF document for printing on demand.

The Bowman-Amuah reference, on the other hand, discloses a benefit of XML documents consisting two parts. It discloses first XML file comprising the data itself, which is the data created by the user, and second XML file comprising a description of how said data can be positioned and formatted (col. 41, lines 15-24). Although the reference uses the first and second XML files in customizing user's web pages, it is well known in the art at the time of the invention that these XML web pages can be saved and transmitted to other computers upon the user's request for further printing purposes.

Hansen and Bowman-Amuah are analogous art because they are from the same field of endeavor, which is creating documents in XML.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the Bowman-Amuah method of using the first and second XML files to the Hansen method of creating print data by embedding XML within PDF file.

The motivation for doing so would have been to provide the user more control over document structure by reducing complexity of creating data while maintaining its flexibility (col. 41, lines 3-9).

Therefore, it would have been obvious to combine Hansen with Bowman-Amuah to obtain the invention as specified in claim 1.

2. With respect to claim 2, the Hansen reference teaches that high-resolution images, fonts, and color definitions are embedded in the PDF document (col. 10, lines 22-26 & col. 17, lines 56-59).

3. With respect to claim 3, the Hansen reference discloses an arbitrary printing office for online printing is provided (col. 3, lines 20-33).

4. With respect to claim 4, the Hansen reference discloses XML file describing the layout of the whole document (col. 6, lines 23-28). Also, the Bowman-Amuah reference discloses the second XML file having document structure, which is interpreted as document layout as well as other data structure (col. 41, lines 17-20).

5. With respect to claim 5, the Hansen reference discloses method of creating a questionnaire (job ticket or ticket) based on non-static text elements in the file (col. 3, line 56 – col. 4, line 11).

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6. With respect to claim 6, the Bowman-Amuah reference teaches that the design XML file has a reference to the data XML file (col. 41, lines 15-20).
7. With respect to claim 7, arguments analogous to those presented for claim 1, are applicable. The examiner interpreted "a method" as a "a system"
8. With respect to claim 8, arguments analogous to those presented for claim 2, are applicable.
9. With respect to claim 9, arguments analogous to those presented for claim 3, are applicable.
10. With respect to claim 10, arguments analogous to those presented for claim 4, are applicable.
11. With respect to claim 11, arguments analogous to those presented for claim 5, are applicable.
12. With respect to claim 12, arguments analogous to those presented for claim 6, are applicable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. U.S. Patent 6,462,756 to Hansen et al. discloses a system and method for managing production printing workflow.
14. U.S. Patent 6,631,375 to Jecha et al. discloses a method for allowing a user to create an electronic document, view the document, and upload the document to the print server for subsequent translation to a suitable prepress format.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Csp

October 30, 2003


EDWARD COLES
SUPERVISOR
EXAMINER
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